

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 33, 35-38 and 40-53 are now pending in this application. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112.

II. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 33 and 35-51 were rejected as allegedly being obvious over Schäfer et al. (US 4,424,808 – “Schäfer”) in view of Fabo (US 5,540,922 – “Fabo”) and/or Lindqvist et al. (US 6,051,747 – “Lindqvist”).

Claims 41-51 were rejected as allegedly being obvious over Schäfer et al. (US 4,424,808 – “Schäfer”) in view of Fabo (US 5,540,922 – “Fabo”) and/or Lindqvist et al. (US 6,051,747 – “Lindqvist”) as applied to claim 40 and in further view of Gantner et al. (US 2007-0202245 “Gantner”).

As both rejections rely at least on the combination of Schäfer, Fabo and/or Lindqvist, these rejections are addressed collectively below.

A. Combination of Schäfer, Fabo, Lindqvist and/or Gantner does render obvious amended claim 33 which now includes the element of previous claim 39

The rejection of Schäfer, Fabo, Lindqvist further in view of Gantner (for claims 41-51) did not include claim 39. While the Schäfer, Fabo and/or Lindqvist rejection did include claim 39 in the header, the explanation of the rejection did not include a discussion of how the element that “the adhesive is applied across the entire surface of or on a part of the underside of a carrier bandage or in the form of patterns” was described by the combination of Schäfer, Fabo and/or Lindqvist. Therefore, for this reason alone, claim 33 as amended is unobvious over Schäfer, Fabo, Lindqvist alone or further in view of Gantner.

The applicants contend that the previous arguments are still applicable and reserve the right to file a continuation application to continue prosecution on the scope of previous claim 33. However, the applicants would like to address a couple of points which were raised in the “Response to Arguments” section of the Office Action.

First, with regard to the elasticity of the bandage, the applicants note that this bandage is claimed as being used for supporting joints and the state of the art is such that it cannot be presumed that a previously known bandage would have the applicants claimed degree of elasticity.

As noted in the background section, having high elasticity to prevent folding of the bandage is accompanied by the bandage losing function for being able to support a joint (see paragraph [0004] of the publication of this application – U.S. Patent Appl. Pub. 2007-0179418).

Second, the Office Action appears to treat bandages for joint support (Schäfer) as being indistinguishable from bandages for wound dressing (Fabo and Linqvist)¹. However, there is no expectation of success for taking an isolated element from a bandage intended for wound dressing would be useful for a bandage intended for providing joint support and actually serves to teach away from the claimed invention in that one of ordinary skill in the art in the wound dressing arts would not want the level of support in a joint support bandage in order to avoid reinjuring the wound or any pain associated with removing a wound dressing bandage.

Therefore, the applicants’ claimed unidirectionally elastic adhesive bandage is not obvious over the combination of Schäfer, Fabo, Lindqvist and/or Gantner for the claims as amended.

B. Consideration of the applicants’ invention and the cited references as a whole for determination of obviousness extends to the dependent claims and is not limited to the independent claims

The only independent claim currently under examination is claim 33 and each of claims 35-38 and 40-53 which are either directly or indirectly dependent upon claim 33. As such, the applicants’ dependent claims are unobvious for the reasons cited above in section A. However,

¹ Gantner appears to be relied for their reference to adhesives in general. Applicants note that should prosecution go to appeal, the Gantner reference could be disqualified as prior art if the applicant files a certified English language translation of their German priority document (DE 10 2004 012 442.6) as this has an earlier priority date (**13 March 2004**) than the earliest 102(e) date of the Gantner reference (**8 April 2004**).

the determination of obviousness also requires that the dependent claims be considered as a whole. By way of example, when tracking the claim dependencies, new claim 53 is actually a composite of the elements represented by claims 33, 40, 41, 42, 49, 50 and 53 (reproduced below):

33. (Currently amended) A unidirectionally elastic bandage, adhesive on one side and used for supporting joints, comprising a backing layer, an adhesive layer and a releasable protective layer

characterized in that the bandage is embodied as a segment and has an elasticity of the backing layer in the range of 20% to 150% and that the adhesive layer has an adhesion force of 1.0-10.0 N,

characterized in that the bandage segment is transversely elastic or longitudinally elastic,
and

characterized in that the adhesive is applied across the entire surface of or on a part of the underside of a carrier bandage or in the form of patterns.

40. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 33, characterized in that the adhesive composed of self-adhesive polymers is selected from the group consisting of polyacrylates, silicones and polyisobutylenes.
41. (Currently amended) The unidirectionally elastic adhesive bandage as claimed in claim 40, characterized in that the elasticity of the backing layer lies in the range of between 44% and 56% ~~adhesive composed of self-adhesive polymers is selected from the group consisting of polyacrylates and polyisobutylenes.~~
42. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 41, characterized in that the backing layer is microbiologically nondegradable to an extent of more than 90%.

45. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 42, characterized in that of the backing layer is a woven fabric or a film or a combination of both made from viscose, polyester, polyamide, cotton or elastane.
49. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 45, characterized in that the backing layer has a warp number in the range of 300-350, and a weft number in the range of 100-140.
50. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 49, characterized in that the backing layer has a warp number in the range of 310-330 and a weft number in the range of 120-130.
53. (New) The unidirectionally elastic adhesive bandage as claimed in claim 50, characterized in that the bandage segment is rectangular with a side ratio of length to width of 1.2:1 to 1.8:1.

When determining the obviousness of a dependent claim such as claim 53, the issue is not whether the individual additional element is obvious, but whether the claimed invention as a whole is obvious, i.e. it would have been obvious for all of the elements represented by claims 33, 40, 41, 42, 49, 50 and 53 simultaneously present.

In this regard, the specific combination of elements represented by claim 53 is not taught or suggested or obvious as a whole when considering the combination of Schäfer, Fabo, Lindqvist with or without Gantner. While there is no limitation on the number of prior art references which can be used to establish a holding of obviousness, consideration of the prior art references as a whole means that the teachings beyond what is being relied upon in the rejection must also be considered.

It has long been held that *"[i]t is impermissible* within the framework of section 103 *to pick and choose* from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly

suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)).

As such, the collective teachings of Schäfer, Fabo, Lindqvist with or without Gantner does not represent a finite number of predictable solutions to a problem especially not for the specific combination of references represented by claim 53. By way of analogy, it is not logical to assert that the winning Powerball lottery numbers would have been obvious because it was known that the numbers to be selected was known to be 1-50. Likewise, it would not have been obvious for the specific combination of elements represented by claim 53 to have been obvious when considering all of the teachings (not just the sections relied upon) represented by Schäfer, Fabo, Lindqvist with or without Gantner.

(The applicants' arguments were directed toward claim 53 as being the best example of the position taken. However, these arguments also apply to the combination of elements represented by the other dependent claims, i.e. 35-38 and 40-52.)

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/
Marilyn M. Brogan Howard C. Lee
Reg. No. 31,223 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500